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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,445	07/09/2003	John Clark	88197.000007	9142
23387	7590	02/12/2004		
Stephen B. Salai, Esq. Harter, Secrest & Emery LLP 1600 Bausch & Lomb Place Rochester, NY 14604-2711			EXAMINER MITCHELL, KATHERINE W	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/616,445

Applicant(s)

CLARK ET AL.

Examiner

Katherine W Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/9/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 IDS's.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-9<sup>9</sup>, drawn to wave attenuating system, classified in class 405, subclass 30.

II. Claim 20, drawn to generally cubical hollow module, classified in class 52, subclass 503.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it can use modules that do not disrupt laminar flow or blocks and does not require longitudinal projections on the inclined surface of the recess portion. The subcombination has separate utility such as modules for riparian improvement structures or building blocks, as there is no positive recitation of use deflecting waves.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. During a telephone conversation with Ms Donna Suchy on 1/16 and 20/2004 a provisional election was made without traverse to prosecute the invention of group I, claims 1-19. Affirmation of this election must be made by applicant in replying to this Office action. Claim 20 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

#### ***Information Disclosure Statement***

6. Examiner notes for the record the excellent job of disclosure of relevant art by applicant.

#### ***Specification***

7. The first paragraph should be amended to refer to the issued patent rather than the application serial number.

#### ***Claim Objections***

8. Claims 2 and 11 are objected to because of the following informalities:

Claim 2 does not end in a period.

Claim 11 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The antecedent basis is unclear. Claim 15 recites a "connector means", but depends on claim 10, which recites a "connector". Also, the word "means" is preceded by the word(s) "connector" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). It is assumed applicant intends to claim only "connector".

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1,2,5,7-8,10-12,15,17-18 are rejected under 35 U.S.C. 102(b) as anticipated by Bishop et al. US Patent 5879105, hereafter called Bishop.

Re claim 1,10,11: Bishop teaches a wave energy dissipating system comprising a plurality of modules, each module (22, Figs 2-14) comprising a generally cubical body, opposite sides, a top and bottom, described as hollow in col 6 lines 50-54 and 60-65, a pair of opposed flanges attached to adjacent corners of the body (44), a flange at each corner of the body, flanges arranged as opposed pairs having axially aligned mounting apertures (56) in the flanges arranged to receive a connector extending thru the apertures for connecting adjacent module to one another (Figs 1, 10,12,14, and col 8 lines 1-19) and that the front face has a wave deflecting recessed portion disposed along a longitudinal edge of the body between a pair of opposed flanges (the plane portion 40 for example in Fig 2, considering the 2 flanges with "54" marked on them to be opposed). Figs 11 and 13 best show the wave deflection as described in col 7, lines 7-48 and col 8 line 57 – col 9 line 34, and a wave incoming to the face 36 shown in Fig 2 would inherently be deflected towards the vertical, as 36 is perpendicular to the incoming wave and thus an angled surface at the top (top defined as upward toward sky) of 36 would result in deflection toward vertical. Bishop et al. teach a module with 6 generally truncated pyramidal surfaces in Figs 2 and 3. For example, a six sided, (Fig 2) generally cubical body with each face comprising a generally rectangular surface, a plurality of trapezoidal surfaces (60) arranged in a generally pyramidal configuration, with a second rectangular surface (36) is taught in Figs 2-7 and col 5 lines 13-40. Four

sides "60" and top "36" form a generally truncated pyramid in Fig. 2, and this pyramidal structure is also a generally rectangular side of the generally cubical module.

Re claims 2, 12: Frustrum facing a frustrum of an adjacent module is shown in Fig 11 and 13. Note the water flow restriction shown in Fig 11.

Re claims 5, 15: Connectors extending longitudinally thru the recessed portion are taught in col 7 lines 9 col 8 lines 47.

Re claims 7-8, 17-18: A brace across the top of attached modules, forming a floating structure, is taught in col 8 lines 1-34 and col 9 lines 28-33.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 3-4 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bishop et al. US Patent 5879105 in view of Dougherty. Bishop teaches a flexible rod (58) connecting a first and second module in col 9 lines 24-34 and col 6 lines 14-20. However, Bishop et al. use cables as the connecting rods and does not teach rigid rods. Dougherty teaches rigid rods {bolts, 47,54} through flange apertures to connect multiple breakwater modules in Figs. 4 and 5, col 4 lines 51-68 and col 5 lines 13-23. Dougherty notes in col 4 lines 65-68 that flexible cables could be used with different connecting disc flanges instead of the bolts used with the spool flanges. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

have modified Bishop to include rigid connector rods as taught by Dougherty in order to connect modules with conventional connectors available cheaply and standardly.

15. Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bishop et al. US Patent 5879105. As discussed above, Bishop teaches all the elements except a frustrum of a rectangular pyramid standing out from the planes of each face/side/top/bottom of the cubical body. Bishop does teach a pyramidal shape standing out from the planes of each face/side/top/bottom of the cubical body, as best seen in Fig. 12. Note that the shape formed from 40/28/40, as well as 60/36/60, is broadly considered a frustrum of a pyramid. However, Bishop does not have a *rectangular* pyramid formed from 40/28/40. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have made all the projections the same shape, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, and substituting similar shapes with no criticality or unexpected results involves only routine skill in the art.

16. Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bishop et al. US Patent 5879105, hereafter called Bishop in view of Karnas USP 4341489

Re claims 9 and 19: Bishop teaches a wave energy dissipating system as discussed above. However, Bishop does not disclose that the system can be used as a beach wall. Bishop is clear that the modules can be filled with sand or concrete, (col 9



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lines 8-12. Examiner takes official notice that using blocks or modules to form a beach wall is well known:

## **sea wall**

**sea wall** also **sea-wall** (sê'wôl') *noun*

An embankment to prevent erosion of a shoreline.<sup>1</sup>

And thus it would be obvious to one of ordinary skill in the art at the time the invention was made to use the blocks with heavy filler as beach walls to further stabilize the shoreline in order to maximize the applications and sales potential.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W Mitchell whose telephone number is 703-305-6713. The examiner can normally be reached on Tues-Fri 9 AM - 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-308-8623 for After Final communications.

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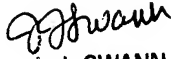
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

kwm

Feb 9, 2004

  
J. J. SWANN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600